

REMARKS**Status of the Claims**

Claims 1-11 are pending in this application. No claims have been canceled or added. Claim 1 is amended to further clarify that the compound must satisfy item (iv) and at least one of items (i) to (iii). No new matter has been added as the broadest disclosure in the present application discloses a material comprising any combination of compounds meeting the requirements of items (i) to (iv); thus, the combination where item (iv) is always satisfied is encompassed by the original disclosure.

Rejection under 35 USC 112, first paragraph

The Examiner rejects claims 1-11 as containing subject matter that is allegedly not described in the original disclosure. Applicant traverses the rejection and respectfully requests the withdrawal thereof.

The Examiner maintains that the specification does not support the phrase "but does not contain hydrazine derivative". The Examiner states that the specification does not convey that the inventors contemplated an embodiment of the invention at the time the application was filed where the material would contain no hydrazine derivative. The Examiner points to page 75, lines 24-25 of the specification which states that various hydrazine derivatives may be used in combination.

Applicant submits that the language pointed out by the Examiner is alternative language and that Applicant may claim any embodiment of the invention disclosed in the specification. This language means that various hydrazine derivatives can be used in the photothermographic material or that the photothermographic material may be free of any hydrazine derivatives.

The specification also states at page 42, lines 32-35 alternative language for the presence of a hydrazine derivative, as follows: "if a hydrazine derivative is used as the aforementioned compounds of (i) to (iii), storability of the photothermographic material before development may be degraded or fog may be increased." Applicant submits that this text in the specification clearly describes and suggests a thermophotographic material that is free of a hydrazine derivative.

If one of ordinary skill in the art desires to obtain a low fog and long shelf life photothermographic material, then one making the invention of claim 1 and also relying on the teachings in the specification would not use a hydrazine derivative in the photothermographic material. See Table 17 in the specification for evidence of high fog and poor shelf life when a hydrazine derivative is used. In addition to the above, please also see the first paragraph at page 138 of the specification regarding sample no. 1-5 that uses a hydrazine derivative as compound Y.

Furthermore, where an element of the invention is present in the alternative, that particular element need not be present in the claimed invention. An applicant may elect to claim a particular embodiment of a much broader disclosure that is described in the specification.

For example, see the Federal Circuit decision in *Union Oil Co. of California v. Atlantic Richfield Co.*, 54 USPQ2d 1227 (Fed. Cir. 2000), where written description was an issue in part B of the decision. Relying on precedent, the court stated that "written description requirement does not require the applicant 'to describe exactly the subject matter claimed [instead] the description must clearly allow persons of ordinary skill in the art to recognize that [he or she] invented what is claimed.'" This case involved an attempt to invalidate a patent claim that recited a particular combination of compounds having specific ranges. The specification of the patent in suit did not have an explicit written description of the claimed combination. However, the specification did teach advantages to be gained by the particular combinations and particular ranges in the combinations. The court in that case found that there was adequate written description because one of ordinary skill in the art would understand that applicant was in possession of the claimed invention at the time of filing. Written description need not be exact, it must only be sufficient to convey the invention to one of ordinary skill in the art.

Applicant submits that the present case is similar to this *Union Oil* case. In the present specification, many embodiments with different combinations of items (i) to (iv) are disclosed and the disclosure suggests that it is advantageous not to use a hydrazine derivative. Thus, Applicant submits that the Examiner is using an improper standard for finding no written description. As such, Applicant respectfully requests that this rejection be withdrawn in light of the above arguments and case law.

The Examiner also rejects claims 1-11 as containing subject matter that is not described in or supported by the original disclosure in the specification for the phrase "at least one compound satisfying (iv) and at least one of (i) to (iii)".

Applicant amends the claims to recite that the compound must satisfy item (iv) and at least one of items (i) to (iii). No new matter has been added because the broadest disclosure in the present application discloses a material comprising a compound meeting any combination of the requirements of items (i) to (iv). As such, Applicant submits that the combination where item (iv) is always satisfied is encompassed by the original disclosure.

As stated above, the Federal Circuit in *Union Oil*, states that where the original disclosure contemplates a combination of several elements, Applicant is free to claim any combination of the elements. Thus, amending the claims to require that item (iv) is always present is not new matter where the original disclosure

states that the compound may meet the requirements of any combination of items (i) to (iv).

Moreover, Applicant submits that the Declaration submitted with the RCE filed February 2, 2004 is consistent with the embodiment of the present invention where the compound meets the requirements of item (iv) and also at least one of items (i) to (iii).

For the foregoing reasons, Applicant submits that both new matter rejections are improper and should be withdrawn.

Rejections under 35 USC 103(a)

The Examiner rejects claims 1-8 and 10-11 as obvious over Ito '084 in view of JP '447, Eschelman '637, Lok '112 or Lok '270. Applicant traverses the rejection and respectfully requests the withdrawal thereof.

Applicant submits that Ito '084 fails to disclose or suggest the material of the present invention having no hydrazine derivative and having a compound that satisfies (iv) and at least one of items (i) to (iii). Moreover, Applicant further submits that no one of ordinary skill in the art would be able to predict that samples B-1 to B-4 in the Declaration filed February 2, 2004 would have a much better/higher Dmax and smaller variation of line width as compared to Samples A-1 to A-5.

Additional evidence of the poor effect of a hydrazine derivative is seen in the comparison of Samples 1-4 and 1-5 in Table 17 in the specification. Both Samples 1-4 and 1-5 contain a sensitizing dye. However, Sample 1-4, like the present invention, does not contain a hydrazine derivative and yet Sample 1-5 contains a hydrazine derivative as compound Y. Samples 1-4 and 1-5 also show that the sensitizing dye has no effect on the properties; yet, the presence of the hydrazine derivative has a surprisingly significant effect on Dmax and line width variation.

For the foregoing reasons, Applicant submits that the present invention is not made obvious over Ito '084 and the cited combination of secondary references. None of the secondary references compensate for the deficiencies in Ito '084. As such, this rejection should be withdrawn.

The Examiner rejects claim 9 as obvious over Ito '084 in view of JP '447, Eshelman '637, Lok '112 or Lok '270 and further in view of Hahm '210. Applicant traverses the rejection and respectfully requests the withdrawal thereof.

Applicant relies on the arguments above regarding Ito '084 to traverse this rejection. Hahm '210 fails to compensate for the deficiencies in the primary and secondary references. Thus, the cited combination of references is also overcome by the above arguments. Applicant respectfully requests that this rejection also be withdrawn.

Conclusion


Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Kecia J. Reynolds (Reg. No. 47,021) at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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Attachment: *Union Oil Co. of California v. Atlantic Richfield Co.*

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